

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte DAVID D. MURESAN and DAVID MURESAN

Appeal No. 1998-3357  
Application No. 08/653,425

ON BRIEF

Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.  
BARRY, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claim 1. We affirm.

#### BACKGROUND

The invention at issue in this appeal is a mouse for moving a cursor on the display of a computer. In a conventional mouse, a wheel presses a rubber ball against X- and Y-coordinate shafts. As the mouse is moved on a surface, the ball rotates the shafts. Because of friction between the ball and the wheel, the mouse often sticks and the wheel requires cleaning.

In contrast, the appellants' mouse employs a magnet and a ball having a magnetic core. The magnet creates a force that presses the ball against X- and Y-coordinate shafts of the mouse. Because the magnet does not touch the ball, there is no friction therebetween.

Claim 1, the only claim, follows:<sup>1</sup>

1. The Computer Mouse comprising:

a magnet which attracts the rubber magnetic core ball against the X and Y coordinate shafts.

The prior art applied in rejecting the claims follows:

Toyoda et al. (Toyoda) 5,371,516 Dec. 6, 1994.

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being obvious over Toyoda. Rather than reiterate the arguments of the appellants or examiner in toto, we refer the reader to the brief<sup>2</sup> and answer for the respective details thereof.

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<sup>1</sup> We rely on and reproduce the claim in the answer, (Examiner's Answer at 5), because the examiner indicates, "[c]laim 1 contains substantial errors as presented in the Appendix to the brief." (Id. at 2.)

<sup>2</sup> We rely on and refer to the supplemental appeal brief, (Paper No. 12), in lieu of the original appeal brief, (Paper No. 9), because the latter was defective. (Paper No. 13.)

OPINION

In deciding this appeal, we considered the subject matter on appeal and the rejection of the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the record, we are persuaded that the examiner did not err in rejecting claim 1. Accordingly, we affirm.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

In addition, the references represent the level of ordinary skill in the art. See In re GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995) (finding that the Board of Patent Appeals and Interference did not err in concluding that the level of ordinary skill was best determined by the references of

record); In re Oelrich, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("[T]he PTO usually must evaluate ... the level of ordinary skill solely on the cold words of the literature."). Of course, "[e]very patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed ....'" In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977) (quoting In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 424 (CCPA 1973)). Those persons "must be presumed to know something" about the art "apart from what the references disclose." In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). With these principles in mind, we consider the examiner's rejection and the appellants' argument.

The examiner asserts, "it would have been obvious to one of ordinary skill in the art to employ the feature of using magnet and magnetic core ball in a mouse because Toyoda et al admits that is conventional for a mouse to employ a rotatably supported ball (which can be the magnetic core ball as above)."

(Examiner's Answer at 3.) The appellants argue, "Toyoda's Pen mouse has three contacts (X and Y coordinate shafts and wheel 52)." (Supp. Appeal Br. at 1.) They further argue, "[i]n

our invention the magnet M in fig. 2 allows to replace the 3<sup>rd</sup>  
[sic] contact ...." (Id. at 2.)

"[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. ... [T]he name of the game is the claim ...." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims--American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)). "In the patentability context, claims are to be given their broadest reasonable interpretations. Moreover, limitations are not to be read into the claims from the specification." In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).<sup>3</sup> Moreover, "[a] transitional term such as 'comprising' or ... 'which comprises,' does not exclude additional unrecited elements, or steps ...."

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<sup>3</sup> Claims are given such interpretation because during examination an "applicant may then amend his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified." In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1271, 229 USPQ 805, 812 (Fed. Cir. 1986).

Here, claim 1 specifies the following limitations: "[t]he Computer Mouse comprising: a magnet which attracts the rubber magnetic core ball against the X and Y coordinate shafts." Giving the claim its broadest reasonable interpretation, the limitations require a ball in contact with at least X- and Y-coordinate shafts. Because the claim uses the transitional term "comprising," however, it does not preclude additional contacts.

The prior art would have suggested the limitations. Specifically, the appellants' argument admits that Toyoda's ball is in contact with its X- and Y-coordinate shafts. For its part, the reference teaches, "the ball 8 is reliably held in contact with the conversion output shafts 20X, 20Y under magnetic forces from the magnet 49." Col. 11, ll. 18-20. Because the reference's ball is in contact with at least its X and Y coordinate shafts, we are persuaded that the teachings of Toyoda would have suggested the limitations of "[t]he Computer Mouse comprising: a magnet which attracts the rubber magnetic core ball

against the X and Y coordinate shafts." Therefore, we affirm the rejection of claim 1 as being obvious over Toyoda.

CONCLUSION

In summary, the rejection of claim 1 under § 103(a) is affirmed. Our affirmance is based only on the arguments made in the brief. Arguments not made therein are neither before us nor at issue, but are considered waived.

AFFIRMED

STUART S. LEVY  
Administrative Patent Judge

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